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10/566,648

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John M. Newsam

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KATTEN MUCHIN ROSENMAN LLP  
(C/O PATENT ADMINISTRATOR)  
2900 K STREET NW, SUITE 200  
WASHINGTON, DC 20007-5118

EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/566,648 | <b>Applicant(s)</b><br>NEWSAM ET AL. |  |
|                              | <b>Examiner</b><br>DWAYNE K. HANDY   | <b>Art Unit</b><br>1797              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/01/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-5, 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lebl et al. (6,045,755). Lebl teaches a system for combinatorial chemistry. The system is best shown in Figures 1-8B and described in columns 17-24. The system includes a plurality of reaction vessels that may be sealed by a rod (Figures 6B and 6C), plate (Figures 5A-5C), or ball (Figures 2A, 4A and 4B). The embodiment in Figure 8 includes a receiver plate (211) having a plurality of receiver well holes (213) and one or more cylindrical rods (206) having a transverse through hole leading to the reaction vessel. Lebl teaches the use of multiple arrays of 384 or more wells in column 13.

3. Claims 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kayyem et al. (US 2002/0006643). Kayyem teaches a device and method for amplification and detection of nucleic acids. The device may include a 96 well

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microplate (Paragraph [0430]) with electrodes. The sample may be tissue (Paragraph [0066]). The Examiner considers this to meet the limitation of skin. In addition, Paragraph [0066] recites samples comprised of other body secretions such as saliva. The Examiner considers these as meeting the limitation of skin debris since these secretions would include skin debris. The method includes providing the well plate and placing the sample in the wells, exposing the sample to an electric charge and then analyzing the tissue debris by absorbance (See [0428]) or fluorescence after mixing with a dye (See [0430]). Kayyem teaches electronic measurement with use of Fourier transforms and electronic fingerprinting in Paragraphs [0439] - [0479]. Kayyem teaches mixing by gravity, electrostatic and magnetic forces in Paragraph [0172].

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Nauck et al. (US 2005/0260101). Nauck teaches an article having a plurality of wells and a closure element comprised of magnetic spheres (Paragraph [0033]). .

5. Claims 16 and 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodner et al. (6,805,842). Bodner teaches a container for minimizing evaporation of a sample. The device is comprised of a container housing and a collapsible sample bag contained within the housing. The device is best shown in Figures 1 and 2. Figure 3 show an array of containers having the collapsible bag feature. The collapsible bag includes a membrane (i.e. skin) that seals the container and allows one-way access to the contents of the collapsible bag (column 4).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodner et al. (6,805,842) in view of Kayyem et al. (US 2002/006643). Bodner, as discussed above, teaches every element of claim 17 except for the electrode. Kayyem teaches a device for electrical analysis of samples. The device may include a microwell plate that includes electrodes for electrical analysis. It would have been obvious to one of ordinary skill in the art to combine the electrodes from Kayyem with the device of Bodner. Bodner teaches a device for collection of sample, but requires removal of the samples. One would add the electrodes from Kayyem perform analysis of the samples in the wells as in Kayyem.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 11:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797

May 22, 2010

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